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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,891	09/23/2003	Kenneth Lathrop	20339.14	3601

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EXAMINER
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PANDYA, SUNIT

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/668,891	<b>Applicant(s)</b> LATHROP ET AL.	
	<b>Examiner</b> Sunit Pandya	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/17/2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Oath/Declaration***

Acknowledgment is made of applicant's Oath/Declaration meets the standard required by 35 U.S.C. 25 & 115.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Illinois State Lottery Department ("pick 3" gaming method implemented 1989, "pick 4" gaming method implemented 1991).

Claim 1: State Lottery discloses of an Indicia game method for accepting entry from plurality of players, wherein each entry comprises of predetermined number of entry numbers to be picked by the players. The state determines the outcome of the lottery games by drawing or selecting random winning numbers, and comparing the drawn winning numbers with the entry numbers picked by the players to determine whether each entry is a winning entry or not (pages 2&10). However the State Lottery dept. does not teach of drawing the multi-digit drawing numbers being independently determined by different lottery jurisdiction.

At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to have allowed drawing the multi-digit

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drawing numbers being independently determined by different lottery jurisdiction, because applicant has not disclosed that having different jurisdictions pick winning numbers, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with having one state do all the winning number drawings. Therefore it would have been an obvious matter of design choice to modify the winning number drawing methods by State Lottery dept. to obtain the invention as specified in claim 1.

Claim 2: State lottery dept. discloses a lottery game for plurality of players where, the predetermined number of entry number is three. The said game is referred to by the lottery dept. as "pick 3" (page 2).

Claims 3, 4, 7, 8, 13, 24 & 25: The state lottery dept. discloses comparing the entry numbers, with the winning numbers, regardless of the order, which the gaming commission refers to as "Boxing" or "box" (pages 4&5). Box betting indicates the bet on all combinations of the chosen or entered number, regardless of the order of the digits; in order to obtain a winning jackpot the winning numbers should appear regardless of the order. State lottery also discloses comparing the order of the entry number with the exact order of the winning number, which is referred as "Straight" (pages 4&5). In order to obtain the winning jackpot, all the numbers should appear in the exact order.

Claims 5, 17 & 31: State lottery dept. discloses a multi-state lottery where plurality of states sponsors the lottery and combine the winning jackpots. However the

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drawing for the winning numbers is held in one of associated states, instead of dividing the drawings in different states.

At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to have allowed for plurality of states to hold the winning drawings, because applicant has not disclosed that having different states pick winning numbers, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with having one state do all the winning number drawings. Therefore it would have been an obvious matter of design choice to modify the winning number drawing methods by State Lottery dept. to obtain the invention as specified in claims 5, 7 & 31.

Claims 6, 9, 22 & 23: State lottery dept. discloses offering players a progressive jackpot prize, to win the jackpot all of the multi-digit entry numbers should match the winning numbers. The number could match regardless of the order or in "box" format, or could match in "straight" format (page 10).

Claim 10: State lottery dept. discloses a betting game where each of the multi-digit entry numbers comprises of three digits. This gaming method is referred to by the state lottery dept. as "Pick 3" (page 2).

Claim 11: State lottery dept. discloses a betting game where each of the multi-digit entry numbers comprises of four digits. This gaming method is referred to by the state lottery dept. as "Pick 4" (page 2).

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Claims 12, 15 & 16: State lottery dept. discloses drawing winning numbers depending on the game types. For the game of "pick 3", there are three winning numbers drawn, for the game of "pick 4", there are four winning numbers drawn (pages 2&4).

Claims 14, 18-21: State lottery dept. allows the players to specify comparison for entry numbers with the winning number. The winning jackpot is based on the comparison types, "straight and/or box" (pages 4&5). For "straight" the entry number should appear in the exact order as the winning number, for "box" the entry number should appear regardless of the order.

Claim 26: State Lottery dept. discloses of accepting an entry from plurality of players, wherein each entry comprises of predetermined number of multi-digit entry numbers. The state determines the outcome of the lottery games by drawing or selecting random winning numbers, and comparing the drawn winning numbers with the multi-digit entry numbers to determine whether each entry is a winning entry or not (page 2&10). However the State Lottery dept. does not teach of drawing the multi-digit drawing numbers being independently determined by different lottery jurisdiction.

At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to have allowed drawing the multi-digit drawing numbers being independently determined by different lottery jurisdiction, because applicant has not disclosed that having different jurisdictions pick winning numbers, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's

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invention to perform equally well with having one state do all the winning number drawings. Therefore it would have been an obvious matter of design choice to modify the winning number drawing methods by State Lottery dept. to obtain the invention as specified in claim 26.

Claim 27: State lottery dept. discloses a betting game where each of the multi-digit entry numbers comprises of three digits. This gaming method is referred to by the state lottery dept. as "Pick 3" (page 2).

Claims 28 & 30: The state lottery dept. discloses comparing the entry numbers, with the winning numbers, regardless of the order, which is referred to as "Boxing" or "box" (pages 4&5). Box betting indicates the bet on all combinations of the chosen or entered number, regardless of the order of the digits; in order to obtain a winning jackpot the winning numbers should appear regardless of the order. State lottery also discloses comparing the order of the entry number with the exact order of the winning number, which is referred as "Straight" (pages 4&5). In order to obtain the winning jackpot, all the numbers should appear in the exact order. However the State lottery only teaches of a single entry number it does not mention of a specific predetermined order for the digits to appear in the entry numbers.

At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to have three entry numbers as the predetermined number of entry numbers, and to obtain a specific order of digits for each entry numbers, because applicant has not disclosed that having three entry numbers with specific order of digits, compared to one entry number, provides an advantage, is

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used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well without having a specific order for the digits in the entry numbers, because as mentioned in above rejection, it is regarded as an indicia game. Therefore it would have been an obvious matter of design choice to modify state lottery commission methods to obtain the invention as specified in claims 28 & 30.

Claim 29: State lottery dept. discloses a betting game where each of the multi-digit entry numbers comprises of four digits. This gaming method is referred to by the state dept. as "Pick 4" (page 2).

### ***Response to Arguments***

Applicant's arguments filed 3/17/2006 have been fully considered but they are not persuasive.

The applicant argues that the reference does not teach every element disclosed in claims 1 & 26, especially drawing numbers that have been independently determined by other lottery games jurisdiction. The examiner respectfully agrees with the applicant, that the reference does not teach of drawing winning numbers that have been independently determined by the other lottery games jurisdiction, however the scope of the game is to compare the numbers picked by the player/gamers and compare them to the winning numbers that have been drawn by the lottery games jurisdiction. And the reference, Illinois Lottery dept., discloses the lottery game wherein the player selects numbers and the selected numbers are then compared to the numbers drawn/picked by



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the lottery jurisdiction. Regarding the fact that all the winning numbers are drawn/picked by the same lottery games jurisdiction, having multiple independent lottery jurisdiction drawing/picking winning numbers does by no means provide an advantage or patentably differentiates the game from the reference provided and further more the game would work just as efficiently with one lottery jurisdiction drawing/picking winning numbers as it would with multiple independent lottery jurisdiction, therefore having multiple independent lottery jurisdiction drawing/picking winning number does not change the scope of the game. Therefore the rejection is maintained.

The applicant argues that the reference does not teach all of the claimed limitations of claim 12. The examiner respectfully disagrees with the applicant. In response to applicant's argument that the references fail to show certain features of applicant's invention, the examiner notes that the Illinois Lottery dept. game of "pick 3" and "pick 4", wherein one of the games comprises a different number of digits than the other multi-digit entry number, three and four respectively, and since the prior art structure is capable of performing the intended use as disclosed by the applicant, then the prior art reference meets the claim limitations, and therefore the rejection is maintained.

The applicant argues that the reference does not teach all of the claimed limitations as recited in claims 5, 17 and 31. The examiner respectfully disagrees with the applicant, the reference teaches of determining all the winning numbers in the same state. The reference, Illinois Lottery dept., discloses the lottery game wherein the player selected numbers are compared to the numbers drawn/picked by the lottery

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jurisdiction. Regarding the fact that all the winning numbers are drawn/picked by the same lottery games jurisdiction, having multiple independent lottery jurisdiction drawing/picking winning numbers does by no means provide an advantage or patentably differentiates the game from the reference provided and further more the game would work just as efficiently with one lottery jurisdiction drawing/picking winning numbers as it would with multiple independent lottery jurisdiction, therefore having multiple independent lottery jurisdiction drawing/picking winning number does not change the scope of the game. Therefore the rejection is maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

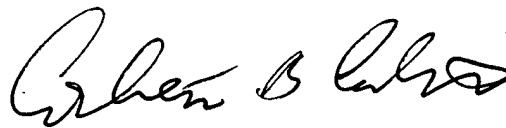
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunit Pandya whose telephone number is (571) 272-2823. The examiner can normally be reached on M - F: 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert OLSZEWSKI can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SP



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PRIMARY EXAMINER